

RECEIVED
CENTRAL FAX CENTER

AUG 13 2007 48170.00040/PC832

REMARKS

This communication is filed in response to the Restriction Requirement mailed on July 12, 2007. Applicants amended claims 10, 11, 24, 25, 34, 35, 39, and 40. No new matter was added by these amendments. Applicants have no intention of abandoning any non-selected subject matter and expressly reserve the right to file one or more continuation or divisional applications directed to non-elected subject matter.

1. Invention Election:

Applicants elect with traverse the claims of Group II (claims 7-15, 21-30, and 36-40). Applicant, however, respectfully request that the Examiner rejoin Group II and Group IV (claims 31-35).

Under MPEP § 803, an application may properly be required to be restricted only if they are able to support separate patents and they are either independent or distinct. However, if the search and examination of all the claims can be made without serious burden, the examiner must examine them on the merits.

Applicants respectfully submit that it would not be an additional burden on the Examiner to search for references bearing on the patentability of amended claims in group IV (claims 31-35). Claims in Group II are drawn to methods of using a protein of Group IV. Clearly, while searching for the methods claimed in Group II, the Examiner will necessarily search for the proteins recited in these methods. Accordingly, Examiner should examine both claims in Group II and claims in Group IV on the merits.

2. Species Election:

Applicants further provisionally elect, with traverse, LMP-1 and HIV-TAT. Claims 7-15, 21-30, 36-40 (Group II) and claims 31-35 (Group IV) read on the elected species. These sequences are claimed in Markush-type claims. The Examiner is respectfully reminded of the general policy regarding Markush-type claims expressed in MPEP § 803.2, namely that it is improper for the Office to refuse to examine that which applicants regard as their invention, unless the subject matter in a claim lacks unity of invention. Unity of invention exists where compounds included within a Markush group 1) share a common utility, and 2) share a substantial structural feature essential to that utility. In the instant application, claims 10, 11, 24, 25, 34, 35, 39, and 40 are Markush

48170.00040/PC832

claims reciting different LMP proteins or their fragments which share a common function, namely, the induction of bone growth and induction of cartilage growth. All of the recited species share substantial structural features. For example, an amino acid sequence comprising SEQ ID NO: 7 encompasses LMP-1. Accordingly, there is a unity of invention because all species share a common utility and share a substantial structural feature essential to that utility. Thus, for at least this reason, Applicants respectfully request the Examiner to withdraw this requirement.

Moreover, pursuant to MPEP § 803.02, it is Applicants' understanding that the entire scope of the claims will be searched and examined. Following a provisional election, the Markush-type claim must be examined fully with respect to the elected species and further to the extent necessary to determine patentability. More specifically, if the Examiner determines that the elected species is allowable, the Examiner must extend the examination of the Markush-type claim to non-elected species. Here, the claims drawn to osteoinductive proteins recite only ten closely related members. Clearly, the examination of all members of the Markush group can be made without serious burden. Thus, the Examiner is requested to examine all members of the Markush group on the merits.

In lights of the foregoing, Applicants respectfully request the examination of all species recited in groups II and IV.

CONCLUSION

Applicants respectfully request that the Examiner rejoin Group II and IV and examine all members of the Markush groups on the merits.

Applicants request that any questions concerning this matter be directed to the undersigned at (609) 844-3021. If a telephone conference would be of assistance in advancing the prosecution of the present application, Applicants' undersigned attorney invites the Examiner to telephone at the number provided.

48170.00040/PC832

Applicants also authorizes the charge of any deficiency and/or the credit of any overpayment to deposit account 50-1943.

Date: August 13, 2007

Respectfully submitted,

Van'w

Vyacheslav Vasilyev, Esq.
Reg. No. 58,154
Fox Rothschild LLP
Princeton Pike Corporate Center
997 Lenox Drive, Building 3
Lawrenceville, NJ 08648-2311